

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
James B. Melesky

Appln. No. 10/024,478 : Art Unit: 3637

Filed: 21 December 2001 : Examiner: A. Phi Dieu Tran

For: INSULATION COVER FOR ATTIC
CLOSURES : Docket No.: 82/1376US
: Formerly: 13811

Commissioner for Patents
Alexandria, VA 22313

REPLY BRIEF

This is a reply to the Examiner's Answer in the above-identified application.

I. REPLY TO EXAMINER'S ANSWER

In this Reply, Appellant demonstrates that the Examiner's Answer fails to show all limitations of the pending claims, in part due to the continued misreading of Waters et al., (4344505) and Helbig (4312423). Further, the Examiner's Answer fails to provide for reasoning sufficient to present a prima facie case of obviousness. Moreover, even if the Examiner was deemed to present a prima facie case of obviousness, Appellant has provided sufficient evidence of secondary considerations to successfully rebut any such prima facie case.

A. The Examiner Has Not Made A Prima Facie Case That Appellant's Device Is Obvious Under 35 U.S.C. § 103(a) In Light Of Waters And Helbig.

A prima facie case of obviousness has not been made as the Examiner fails to show that the combination of Waters and Helbig contains all elements of Appellant's pending claims. Specifically, the Examiner fails to show that the combination of Waters and Helbig contains the following four limitations: (1) Appellant's cover assembly comprises a removable closure member which detaches and can be completely removed from the frame when Appellant's cover assembly is opened; (2) Appellant's claimed frame is placed on a structure surrounding an existing attic access; (3) Appellant's closure member includes a depending central portion engaging the internal frame opening; and (4) Appellant's cover comprises first and second continuous seals on all four sides when the cover member is closed.

1. Waters and Helbig do not show a removable closure member completely detachable from the frame of the device.

The Examiner's Answer fails to show that Waters as modified by Helbig contains a removable closure member that is completely detachable from the frame of Appellant's device as required by claim 14. Appellant's claim 14 requires a removable closure member which

completely detaches from the frame of Appellant's device and is not connected via hinges or any other mechanism to the frame of the device.

In the Answer, the Examiner asserts that Waters shows a continuous frame (26, 20, 24, 22) and a "removable closure member" (28) with the "removable closure member" being separable from the frame. In attempting to support this allegation, the Examiner not only misreads Waters, but the Examiner uses the terms "frame," "cap" and "removable closure member" inconsistently and not in accord with the teachings of Waters. The Examiner also misleadingly states that the cover or sheet (28) of Waters is a "removable closure member" (28). Moreover, the Examiner misreads Helbig and claims that that Waters as modified with Helbig shows a "removable closure member" (28) that can be detached from the frame.

The following chart correctly summarizes the relevant terms for Waters and Helbig:

Term	Device	Element	Description
Cap	Waters	10	The combined device of Waters, including the cover (28) and all four walls (20, 22, 24 and 26). <u>See, e.g.,</u> FIG. 3 which illustrates "an exploded view illustrating a proposed scheme for fabricating the insulated cap of FIG. 1;" Col. 2, ll. 22-23 (emphasis added).
Cover or Sheet	Waters	28	A <u>portion</u> of the cap (col. 2, ll. 54-57) ("a hinge . . . supports one side or end of the cap 10 to the attic floor AF or, preferably, a <u>portion</u> (cover 28) of the cap the side or end walls of the caps [sic]"') (emphasis added). Attached via hinges or secured to the cap (10).
Frame	Waters	20, 22, 24, 26	A <u>portion</u> of the cap (10) as the frame consisting of the sides 20, 22 and ends 24, 26 <u>which are secured together</u> in a rectangular pattern. Col. 2, ll. 64-67) ("[O]ne preferred embodiment in which the cap is formed of the selected insulation material . . . [t]he sides 22, 24 and ends 24, 26 are secured together in a rectangular pattern.") (emphasis added).
Frame	Helbig	12	The frame of Helbig is the preexisting frame of a stairway unit secured to preexisting floor joists. <u>See</u> Fig. 4; Col. 3, ll. 29-36). The frame of Helbig is <u>not</u> part of the device of

			Helbig.
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Employing the appropriate terminology in a consistent manner, it becomes clear that Waters as modified with Helbig fails to show a removable closure member which is completely detachable from the frame of the device as required by Appellant's claim 14. The Examiner misleading refers to the cover or sheet (28) of Waters as a "removable closure member," a phrase never used in Waters. See, e.g., Answer, p. 9 ("Waters et al show a removable closure member (28)"). The "removable closure member" (28) is described only as the cover or sheet (28) of the cap (10) device of Waters and it is only a portion of the cap. Col. 2, ll. 54-57 ("a hinge . . . supports one side or end of the cap 10 to the attic floor AF or, preferably, a portion (cover 28) of the cap the side or end walls of the caps [sic]"') (emphasis added). The "removable closure member" (28), as referred to by the Examiner, is a portion of the cap (10) and is inseparable from the frame (26, 20, 24, 22) portion of the cap (10) of Waters. The Examiner's reference to a "removable closure member" is misleading as Waters does not teach or show that element 28, the cover or sheet, is wholly removable or detachable as required by Appellant's claim 14.

The Examiner also uses the term "frame" inconsistently. The "frame" portion of the cap (10) in Waters is composed of the sides 20, 22 and ends 24, 26 which are secured together in a rectangular pattern and is an integral insulating component. Col. 2, ll. 64-67 ("[O]ne preferred embodiment in which the cap is formed of the selected insulation material . . . [t]he sides 22, 24 and ends 24, 26 are secured together in a rectangular pattern."). The "frame" of Waters is not any preexisting structure, but is an essential portion of the device itself.

The Examiner's misreading of Waters is further demonstrated by the erroneous assertion that "[Waters] thus discloses the cap being the closure member which can be mounted to the

frame in other alternative means.” Answer, p. 9 (emphasis added). The Examiner cites to column 3, lines 1-20 as support for this allegation. However, the proper reading of Waters reveals that the cap (10) can be attached to the attic floor (AF) in alternative manners, not to the “frame.” The cap (10), in fact, cannot be “mounted” to the frame of Waters in any manner as this interpretation of Waters is nonsensical as the frame (20, 22, 24, 26) is but a portion of the cap (10). There is no additional external frame described in Waters upon which to attach the cap (10).

The Examiner’s inconsistent use of terms is also revealed in the assertion that “Waters et al further discloses any manner . . . to move the cap away from its position over the opening . . . and an embodiment would be to hingedly move the cover away from the opening.” Answer p. 4. This assertion confuses the terms “cap” and “cover” as described in Waters. The cap (10) may be moved away from the opening in the attic floor (AF) in any manner. However, Waters teaches that the cover (28) of the cap (10) can only be moved relative to the opening of the attic floor (AF) through the use of hinges. The only other embodiment described in Waters for the cover (28) is for the cover (28) to be secured to the frame such that no movement of the cover (28) relative to the cap (10) is permissible. There is no embodiment described in Waters which would allow for the cover (28) to be completely detached from the frame (20, 22, 24, 26) to create the two-piece device of Appellant’s claim 14.

Modifying Waters with Helbig does not remedy the deficiencies of Waters with respect to teaching a removable and detachable closure member. The Examiner impermissibly conflates the “frame” (20, 22, 24, 26) of Waters and the “frame” (12) of Helbig. The frame element of Waters is a portion of cap (10). Specifically the “frame” of Waters is composed of the sides 20, 22 and ends 24, 26 which are secured together in a rectangular pattern. Col. 2, ll. 64-67. The

Examiner asserts that the “frame” of Helbig consists of element 26 which is the preexisting floor joists of the surrounding structure. See col. 3, ll. 29-48. However, “frame” is defined in Helbig to be element 12, the support frame for the preexisting stairway unit and a separable frame is in no way part of Helbig’s art.

Even if the Examiner’s interpretation is correct, Helbig’s “frame” is not part of the device disclosed and Helbig’s device does not include a continuous frame as required by Appellant’s claim 14. Claim 14 includes three parts: (1) an existing attic opening having a surrounding structure integral to the building’s ceiling, (2) a frame whose lower surface is on that surrounding structure and encloses the existing attic opening, and (3) a removable closure member designed to seal to the frame at its upper and interior surfaces. The Helbig device is only a single piece closure (24) that is placed upon the existing attic structure.

Even if one was to accept that the floor joists (26) were the frame and not the existing structure of a stairway unit (which is clearly contrary to both the teaching of Helbig and a common sense understanding of the structure of an existing stairway unit), the device of Helbig still clearly fails to show all elements of claim 14 as the joists do not have their lower surface supported on a surrounding and integral structure for an existing attic opening. There is no structure shown in Helbig upon which the lower surfaces of the joists are supported. See, e.g., FIG. 7. Accordingly, Helbig’s device is a single piece cover and does not comprise any sort of removable closure member, openable by hinges, complete separation or any other means.

Waters and Helbig essentially show the same two items—a surrounding attic structure and a one-piece cap moveable relative to that attic structure. As shown above, the Examiner fails to show that either reference provides for the device of the present claims. Because the Examiner misreads Waters to show a cover with a detachable closure member, and because

Helbig does not fill this gap, Appellant respectfully contends that the Examiner has not made a prima facie case of obviousness.

2. Waters and Helbig do not show Appellant's claimed frame placed on a structure surrounding an existing attic access.

The Examiner asserts that Waters discloses that the cap (10) (insulating cover) is placed on an existing attic opening ((AF), its supporting structures and C). Answer, p. 9. The Examiner again misuses the term "cover" when referring to the cap (10) of Waters. Appellant's claim requires "an existing attic access having a surrounding structure" and a cover "placed on said surrounding structure," the cover comprising a continuous frame "supported on said surrounding structure" (emphasis added). As shown above, Waters only shows a cap without a removable and detachable closure member that rests on an attic floor. In addition, Helbig is lacking, at a minimum, Appellant's frame. As shown above and discussed in Appellant's Brief, the frame of Helbig is not part of the device of Helbig, but part of the preexisting attic structure or stairway unit. Therefore, the combination of Waters and Helbig does not show the cover comprising the frame and removable closure member placed on a surrounding structure of an existing attic access.

3. Waters and Helbig do not show Appellant's claimed cover including a removable closure member with a depending central portion.

The Examiner asserts that the secondary reference of Helbig provides the requisite depending central portion of a removable closure member. Appellant respectfully traverses the Examiner's statement that Helbig shows a depending central portion. The presumed element 24 which the Examiner asserts shows this central depending element is not "sized and shaped to fit within the frame opening and frictionally and snugly engage the frame 26," as required to show Appellant's claimed depending central portion. Helbig's element 26 does not show such a frame

for a depending central portion to engage on four sides. Thus, Helbig's element 24 does not engage element 26 as a frame as element 26 exists only on two sides. Further, Helbig's element 24 does not "fit within the frame opening" as required to show Appellant's claimed depending central portion. Helbig's element 24 rests on all four sides on the preexisting frame structure of the attic ladder, not a separate frame component of a cover assembly as required by Appellant's claim 14.

Because Helbig's element 24 does not meet the limitations of Appellant's claimed depending central portion, the combination of Helbig and Waters fails to show Appellant's claimed depending central portion and, therefore, the Examiner has failed to make a *prima facie* case of obviousness.

4. Waters and Helbig do not show Appellant's claimed cover assembly comprising first and second seals.

Waters as modified by Helbig does not show a depending central portion with sealing capacity for the closure member with first and second continuous seals. Waters does not show the two orthogonal seals of Appellant's device as it does not show any snug, frictional, interfitting, tight, or perfect closure as necessary to generate a seal as Waters' disclosure of hinges teaches away from a seal.

Helbig does not fill the gaps of Waters, contrary to the Examiner's assertions. Helbig does not create any first and second continuous seals with a continuous frame, but rather only interfaces with two sides at the floor joists (26). Thus, the seals of Helbig are not continuous as Appellant's claim 14 requires. Further, Helbig does not provide for a frame with which a closure member seals. Because Helbig does not show Appellant's frame, Helbig therefore cannot show Appellant's first and second continuous seals with that frame.

Moreover, as discussed in Appellant's Brief, Waters and Helbig are insulative devices designed to prevent only one type of heat transfer—conductive heat transfer. Appellant's device is not only insulative and prevents conductive heat transfer, but the first and second continuous seals of Appellant's device also prevent convective heat transfer by creating an air seal through the first and second continuous seals. The element of Appellant's device is not shown or discussed in Waters or Helbig.

Because the combination of Waters and Helbig does not show Appellant's first and second continuous seals, the Examiner has not made a *prima facie* case of obviousness.

5. The Examiner has not shown a motivation to combine Waters and Helbig, and any such combination would be nonfunctional.

The Examiner asserts that the motivation to combine Waters with Helbig stems from the alleged ability of the combination to enable a secure, easy precise positioning and supporting of the closure member on the frame. See Answer, p. 10. This assertion is without basis as Waters provides for secure and easy positioning of the cover (10) (closure member) on the frame as the closure member of Waters is either hingedly attached to the frame or it is permanently secured to the frame. Moreover, as shown above, the device in Helbig does not contain an insulating “frame” as required by Appellant's claims. Thus, there is no motivation to combine Helbig with Waters.

Additionally, as shown by Appellant's Brief, there can be no motivation to combine Waters and Helbig because that combination is structurally nonfunctional. Among other things, the device of Helbig is necessarily smaller than the hole in the attic floor, as it must rest on the attic ladder component (12) that protrude into the hole between and down within the joists (26). Within that space, Helbig connects only to ladder components (12). See FIG. 7. In contrast, Waters is disclosed to be larger than the hole, having “such outer dimensions as to completely

cover the ceiling opening.” Col. 2, ll. 42-46. The cap of Waters simply sits on the attic floor surrounding the hole with inside dimensions greater than the outside dimensions of Helbig. The two devices therefore cannot be combined, as their sizes relative to the attic floor hole dictated by their means of installation are inapposite.

Thus, even if the combination of Waters and Helbig showed all elements of Appellant’s claims (which it does not), the Examiner has not provided a motivation to combine those references, and the combination of those references is structurally inoperable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

B. Appellant’s Secondary Considerations Rebut Any Prima Facie Case of Obviousness.

Appellant has submitted voluminous evidence of secondary consideration sufficient to rebut any *prima facie* case of obviousness. However, in the Answer the Examiner asserts that many of the declarations and exhibits submitted by Appellant are unclear and insufficiently specific to overcome the rejection. It should be noted that all secondary considerations should be taken into account in the newly “expansive and flexible approach” to obviousness rejections. KSR Int’l Co. v. Teleflex, Inc., 127 S.Ct. 1727, 1729, 1741 (2007). Specifically, the Examiner claims that all references to The Energy Guardian® are not sufficiently clear to show that the structure is that of the current claims.

In support of this allegation the Examiner asks whether the references to The Energy Guardian® in the declarations of Tom Donofrio and George Temme refer to the claimed device and what makes up the kits for the referenced The Energy Guardian®. The Examiner asserts “a quick look” at Appellant’s website does not clarify the issue. Appellant respectfully disagrees and suggests that a full, detailed examination of Appellant’s website (www.essnrg.com) discloses that The Energy Guardian® referenced in the Donofrio and Temme declarations is the

device of claim 14 and the make up of The Energy Guardian® kits is commensurate with the disclosure of Appellant's claims. See also Supp. Rule 132 Dec., dated Feb. 1, 2006; Rule 132 Dec., dated July 27, 2005 (providing "I have reviewed claim 14 of the above referenced application and believe that The Energy Guardian[] embodies the elements of that claim.").

A full and fair review of Appellant's website at www.essnrg.com clearly shows The Energy Guardian® of the declarations and exhibits to be an embodiment of claim 14 through pictures, testimonials and product descriptions found on Appellant's website. Appellant's website states that the first Energy Guardian® kit was introduced in 2002. See Appellant's website at http://www.essnrg.com/co_hist.html. This initial device is the same as described in the claims as revealed by the photographs on the website, the description of the product on the website and the description and photographs provided in the Rule 132 declarations. See, e.g., Appellant's website at www.essnrg.com. A different, non-gravity device was not introduced until 2006. See Appellant's website at http://www.essnrg.com/co_hist.html. Thus, a full, fair and detailed inspection of the website reveals that all declarations and exhibits dated prior to 2006 necessarily refer to the device in Appellant's claims. Moreover, viewing the exhibits and declarations in context with the website provides for further confirmation that the declarations and exhibits correspond to claim 14.

Each exhibit presented by Appellant that references The Energy Guardian® clearly and explicitly refers to the device of claim 14, including the declarations from Donofrio and Temme and exhibits Q, D, E, EE, M, R, S, V, F, FF, U, W, and DD. For instance, the Donofrio declaration is dated September 12, 2005, and the Temme declaration is dated December 12, 2005, both during the time in which the only device available was the one which tracks the device described in claim 14. Moreover, the Donofrio declaration refers to placing The Energy

Guardian® on top of a pull down ladder, clearly indicating that the device of claim 14 was employed.

Exhibits Q, D, E, EE, M, R, S, V, F, FF, U, W, and DD, when viewed in context with the website further show that The Energy Guardian® described is the kit that is commensurate with the scope of the claims. Exhibits D, E, F, S, V, U, W, and DD are all dated prior to 2006. Thus, they too must be The Energy Guardian® of claim 14 as that device was the only one available. Additionally, as shown in Appellant's Brief, many of the Exhibits reference structural components of claim 14: the "seal established as the extension of the lid fits into the frame" (Ex. D); a "two-piece unit" with a "tight air seal" and "a lid that fits into a frame to easily re-establish an air seal when used" (Ex. E); "great" "air-sealing qualities" and "the lid of your kits fits right into the frame without any hooks or other devices to secure the air seal" (Ex. Q); "heavy duty air seal" (Ex. R); actual photographs showing the claimed structure (Ex. V); and "The results are a direct result of the unique design of your kits. The lid with its lip that fits into the frame is the key to the solution." (Ex. EE). Moreover, exhibit V also contains pictures of The Energy Guardian® kit that shows the two piece design of claim 14. Thus, it is unmistakable from the record that exhibits Q, D, E, EE, M, R, S, V, F, FF, U, W, and DD each are commensurate with the scope of claim 14 and the secondary considerations in those exhibits clearly correspond to claim 14 such that they rebut any *prima facie* case by the Examiner.

The Examiner also mistakenly states that "it is expected that once a person limits the area of escape between structures by providing more sealing surfaces, less air would escape a structure resulting in a more insulating structure." Answer, p. 11. The insulative value of a structure relates to its ability to prevent conductive heat transfer and is in no way related to a

structures ability to prevent air from escaping. Appellant's device while being an insulator also provides the unexpected benefit of preventing convective heat transfer through its air seals.

Appellant's commercial success of The Energy Guardian® is also clearly a result of the structure of claim 14. Exhibits U, W, and DD illustrate that the commercial success of Appellant's claimed apparatus is not due to any heavily financed corporate marketing or promotional activity, but significantly from "word of mouth" from enthusiastic actual users about the claimed devices advantages.¹ Appellant's commercial success, generally and as narrated in the record, is clearly the direct result of Appellant's claimed apparatus. There is no requirement that commercial success be controlled by the number of units sold or the number of clients for the product. Thus, the record provides clear and ample support for Appellant's secondary considerations completely rebutting any *prima facie* case, as the product and advantages described in the exhibits clearly are commensurate with claim 14.

Significantly, the Examiner fails to substantively address Appellant's argument that the results of the invention are unexpected and significant. Instead, the Examiner summarily states that "it is expected that once a person limits the area of escape by air between structures by providing more sealing surfaces, less air would escape a structure resulting in a more insulating structure. The combination of the references is thus obvious as set forth above." Answer, p. 11. Appellant respectfully asserts that the Examiner is incorrect. Among other things, the submitted evidence shows that the insulating and sealing capacity of the claimed structure is far from "expected." The skepticism of experts specializing in this field, combined with exhibits establishing the experts were incorrect, establishes that the results are unexpected. See, e.g., Ex.

¹ Had the Examiner performed a thorough review of the Appellant's website (see, e.g.,, http://www.essnrg.com/co_hist.html), he would have noticed that the exhibits and declarations submitted by Appellant are only a representative sample of the success and novelty of Appellant's device.

EE (“We have constantly recorded 200-400 CFM50 reductions for hatches and 600-900 CFM50 reductions for pull down ladders. . . . I did not believe that these reductions were attainable. . . . [S]cientists at Oak Ridge Laboratories [and] experts in the field consistently posit no more than a 50 CFM50 reduction for hatches and a 100-200 CFM50 for pull down ladders are achievable”); Ex. E (“there has never been a product to properly insulate and seal these attic accesses until The Energy Guardian Attic Access covers”); Ex. O, P and H (demonstrating actual average reduction of at least 500 CFM and as high as 1400 CFM when expert prediction was only 100 CFM for device). In light of testimonials presented by Appellant, Appellant respectfully asserts that Appellant’s results are, in fact, significant. The results of Appellant’s claimed structure, including the first and second seals, is unexpected and significant such that these secondary considerations rebut any *prima facie* case by the Examiner.

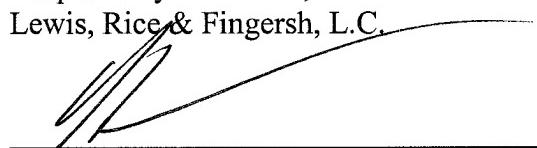
The questions asked by the Examiner in the Answer do not reflect the “expansive and flexible” approach to obviousness mandated by KSR. The KSR standard for obviousness, which encourages expansiveness and flexibility, discourages “rigid preventative rules.” 127 S.Ct. at 1729, 1741, 1742-73. In light of the overwhelming evidence presented by Appellant, it is clear that the product embodying claim 14 is far superior to any other product in its claimed sealing structure. Accordingly, under the expansive and flexible approach mandated by KSR, Appellant’s secondary considerations rebut any *prima facie* case of obviousness notwithstanding these inconsequential concerns by the Examiner.

C. Conclusion Of Argument.

Appellant respectfully concludes that the currently rejected claims are not obvious. First, the Examiner has failed to make a *prima facie* case, as Waters and Helbig do not provide closure members detachable from frames but only single piece or connected “caps.” Second, the cited references do not provide for Appellant’s first and second seals. Third, even if the Examiner did

make a prima facie case (which Appellant denies), Appellant's secondary considerations rebuts that prima facie case, since the device, as commensurate with claim 14, shows unexpected and significant results, and shows commercial success by replacement of inferior products and increased market share. Under KSR, the Examiner's additional concerns are overly rigid and do not prevent Appellant's secondary considerations from rebutting any prima facie case of obviousness.

Respectfully submitted,
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Dated: August 27, 2008

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